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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/400,568	09/21/1999	JOSEPH C. FLOYD	96B037/3	3555

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[REDACTED] EXAMINER

CHEUNG, WILLIAM K

ART UNIT	PAPER NUMBER
1713	26

DATE MAILED: 06/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/400,568	FLOYD ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	William K Cheung	1713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 01 May 2003.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 21-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 21-26, 28 and 29 is/are rejected.
- 7) Claim(s) 27 and 30 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)                    4) Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)                    5) Notice of Informal Patent Application (PTO-152)
- 3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.                    6) Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Request for Continued Examination***

1. The request filed on May 1, 2003 for a Request for Continued Examination (RCE) under 37 CFR 1.53(d) based on parent Application No. 09400568 is acceptable and a RCE has been established. An action on the RCE follows.
2. In view of Amendment (Paper No. 25) filed May 1, 2003, claims 10-20 have been cancelled and new claims 21-30 have been added. Claims 21-30 are pending.
3. In view of Amendment (Paper No. 25) filed May 1, 2003, the rejection of Claims 10, 12, 14, 18-20 under 35 U.S.C. 102(b) as anticipated by Jejelowo et al. (US 5,470,811) is withdrawn. Further, the rejection of claims 11, 13, 15-17 under 35 U.S.C. 103(a) as being unpatentable over Jejelowo et al. (US 5,470,811) is withdrawn.

### ***Suggestions***

4. Please correct following minor informalities:  
Claim 21 (line 2), please amend "an MIR" to "a MIR".

Claim 21 (line 3), please amend "an MWD" to "a MWD".

Claim 26 (line 1), please amend "CDB1" to "CDBI".

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 21, 22, 25, 26, 28, 29 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement.

Set forth from MPEP 2164.08(a), Claims 21, 22, 25, 26, 28, 29 are single means claims, i.e., where a means recitation does not appear in combination with another recited element of means, is subject to an undue breadth rejection under 35 U.S.C. 112, first paragraph. In re Hyatt, 708 F.2d 712, 714-715, 218 USPQ 195, 197 (Fed. Cir. 1983) (A single means claim which covered every conceivable means for achieving the stated purpose was held nonenabling for the scope of the claim because the specification disclosed at most only those means known to the inventor.). When claims depend on a recited property, a fact situation comparable to Hyatt is possible, where the claim covers every conceivable structure (means) for achieving the stated property (result) while the specification discloses at most only those known to the inventor.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. Claims 21-26,28 and 29 are rejected under 35 U.S.C. 102(b) as anticipated by

or, in the alternative, under 35 U.S.C. 103(a) as obvious over Welborn et al. (WO 96/00246).

*The invention of claims 21-26,28 and 29 relates to an ethylene homopolymer or copolymer having:*

- a) an MIR of from 15 to 35;*
- b) a MWD of from 2 to 15;*
- c) a CDBI of  $\geq 60$ ;*
- d) a melt strength  $\geq 25.5$  cN; and*
- e) a melt index of from 0.2 to 10 dg/min.*

Welborn (page 11, line 29 to page 12, line 11) in a working example disclose that the preferred inventive polymer of Welborn et al. is an ethylene/1-hexene copolymer. Further, in the broad disclosure, Welborn et al. (page 8, line 14-32) clearly disclose a series of olefinic comonomers monomers for preparing an ethylene homopolymer or an ethylene copolymer. Regarding properties, Welborn (Page 9, line 26 to page 10, line 15) disclose that the ethylene homopolymer or copolymer have a melt index ranges from about 0.01 to 5 dg/min, a MWD ranges from about 1.5 to about greater than 20, a density range from 0.87 to about 0.97 g/cc, and a MIR preferably in the range from about 14 to about 45. In view of the substantially identical composition, MIR, melt index, and MWD between the claimed ethylene homopolymer or copolymer of claims 21-26, 28 and 29 and the homopolymer or copolymer of Welborn et al., the examiner has a reasonable basis to believe that the claimed CDBI, APS, and the melt strength

properties are inherently possessed by Welborn et al. Since the PTO does not have proper means to conduct experiments, the burden of proof is now shifted to applicants to show otherwise. In re Best, 562 F.2d 1252, 195 USPQ 430 (CCPA 1977); In re Fitzgerald, 205 USPQ 594 (CCPA 1980).

***Allowable Subject Matter***

9. Claims 27, 30 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The closest prior art Welborn et al. are silent on an ethylene copolymer having a comonomer concentration ranges from 0.89 to 1.97 mole %. Therefore, it would not be apparent to one of ordinary skill in art to use the ethylene copolymer teachings in Welborn to obtain the invention of claims 27, 30.

***Conclusion***

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William K Cheung whose telephone number is (703) 305-0392. The examiner can normally be reached on Monday-Friday 9:00AM to 2:00PM; 4:00PM to 8:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (703) 308-2450. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-5885 for regular communications and (703) 305-5885 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

A handwritten signature in black ink, appearing to read "William K. Cheung".

June 3, 2003